

TRANSMITTAL OF APPEAL BRIEF (Large Entity)Docket No.
PHD 98-097/16197In Re Application Of: **Hening Maab, et al.**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/530,253	4/26/2000	Richard Woo	23389	3629	6706

Invention: **ARRANGEMENT AND METHOD FOR LOCATING DATA CARRIERS****COMMISSIONER FOR PATENTS:**

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on

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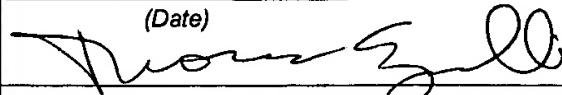
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APPEAL BRIEF

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Henning Maab, et al. **Art Unit:** 3629

Serial No.: 09/530,253

Examiner: Richard Woo

Filed: April 26, 2000

Docket: PHD98-097 (16197)

For: ARRANGEMENT AND
METHOD FOR LOCATING
DATA CARRIERS

Dated: October 25, 2004

Conf. No.: 6706

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APPEAL BRIEF

Sir:

I. INTRODUCTION

Pursuant to 35 U.S.C. § 134 and 37 C.F.R. § 41.37, entry of this Appeal Brief in support of the Notice of Appeal filed August 20, 2004 (and received in the Patent Office on August 24, 2004) in the above-identified matter is respectfully requested. This paper is submitted as a brief setting forth the authorities and arguments upon which Appellants rely in support of the appeal from the Final Rejection of Claims 1-4 in the above-identified patent application on April 20, 2004.

II. STATEMENT OF REAL PARTY OF INTEREST

The real party of interest in the above-identified patent application is U.S. Philips Electronics.

III. STATEMENT OF RELATED PROCEEDINGS

There are no pending appeals or interferences related to this application to Appellant's knowledge. A prior appeal was filed on August 7, 2003. The Examiner re-opened prosecution in an Official Action issued November 10, 2003.

IV. STATEMENT OF SUPPORTING EVIDENCE

No affidavits, documents, or other evidence is being entered into the record in support of this Appeal.

V. STATEMENT OF CLAIM STATUS AND APPEALED CLAIMS

A. Claim Status

Claim 1 stands rejected based on 35 U.S.C. § 102(b) and U.S. Patent No. 5,594,425 to Ladner et al.

Claim 2 stands rejected based on 35 U.S.C. § 102(b) and U.S. Patent No. 5,594,425 to Ladner et al.

Claim 3 stands rejected based on 35 U.S.C. § 102(b) and U.S. Patent No. 5,594,425 to Ladner et al.

Claim 4 stands rejected based on 35 U.S.C. § 102(b) and U.S. Patent No. 5,594,425 to Ladner et al.

Claim 5 has been canceled.

Claim 6 has been canceled.

B. Appealed Claims

Claims 1-4 are appealed, a clean copy of which are attached hereto in Appendix A.

VI. STATEMENT OF AMENDMENT STATUS

The Amendment After Final Rejection filed June 1, 2004 has not been entered for purposes of appeal pursuant to the Advisory Action mailed August 11, 2004.

The amendment filed June 1, 2004, which has not been entered is not reflected in Appendix A and is as follows:

1. (Currently Amended) A locating system comprising:

at least one data carrier located in an area, the at least one data carrier including a position sensor, a transmitter and a receiver;

an information unit which is remote from the at least one data carrier for storing area information and transmitting the area information to the at least one data carrier;

wherein said ~~at least one data carrier~~ transmitter transmits its position of said at least one data carrier to the

information unit only in the case of initialization and movement of the at least one data carrier from the area and wherein a third party interrogates the information unit for the position of the at least one data carrier.

VII. STATEMENT/EXPLANATION OF INVENTION

The parent application, U.S. patent application Serial No. 09/530,253 was filed on April 26, 2000, originally included Claims 1-5. A sixth claim was added in a preliminary amendment filed concurrently with the application.

In an Official Action dated October 30, 2002, the Examiner rejected claims 1 and 2 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,550,551 to Alesio (hereinafter "Alesio"). Furthermore, the Examiner rejected claims 1-6 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,365,451 to Wang et al., (hereinafter "Wang"). Lastly, the Examiner rejected claims 3-6 under 35 U.S.C. § 103(a) as being unpatentable over Alesio.

In a Response under 37 C.F.R. § 1.111, filed January 27, 2003, independent claims 1 and 3 were amended to clarify their distinguishing features and to incorporate the features of original claims 5 and 6.

Specifically, Applicants argued that Alesio does not

teach or suggest "area information is stored in an information unit which is remote from the at least one data carrier and can be transmitted to the at least one data carrier" as is recited in claim 1 and "position data is allocated to an area in the information unit, and the boundaries of the area are transmitted to the data carrier" as is recited in claim 3. Applicants further argued that Wang does not teach or suggest "a third party interrogates the information unit for the location of a data carrier" as recited in claims 1 and 3, as amended.

In the Final Official Action, issued February 11, 2003, the Examiner rejected claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over Wang. A first response under 37 CFR 1.116 was filed on March 24, 2003. Subsequent to a first Advisory Action issued on July 15, 2003, a first Appeal Brief was filed on August 7, 2003. In a non-final Official Action issued on November 10, 2003, the Examiner re-opened prosecution and cited a new rejection under newly found prior art. Specifically, the Examiner rejected claims 1-4 as being anticipated by U.S. Patent No. 5,594,425 to Ladner et al.

Subsequently, Applicants filed a Response on January 27, 2004. The Examiner reiterated the rejection of claims 1-4 in a second Final Official Action issued on April 20, 2004. A second response was filed on June 1, 2004 with an amendment to

claim 1 as set forth in section VI, above. A second Advisory Action issued on August 11, 2004, in which the Examiner refused to enter the amendment to claim 1.

Consequently, Claims 1-4 are the claims on appeal. A copy of the rejected claims is attached hereto in the Appendix.

The invention with respect to claim 1 comprises a locating system comprising: at least one data carrier located in an area (e.g., see page 3, lines 13-15 and Figure 1), the at least one data carrier including a position sensor, a transmitter and a receiver (e.g., see page 3, lines 27-33 and Figure 2); an information unit which is remote from the at least one data carrier for storing area information and transmitting the area information to the at least one data carrier e.g., see page 3, lines 13-26 and Figures 1 and 2); wherein said at least one data carrier transmits its position to the information unit only in the case of initialization and movement of the at least one data carrier from the area (e.g., see page 3, lines 18 and 19 and Figure 3) and wherein a third party interrogates the information unit for the position of the at least one data carrier (e.g., see page 4, lines 1-26 and Figure 3).

The invention with respect to claim 2 comprises a locating system as claimed in Claim 1, wherein the at least one data carrier has a receiver for receiving area boundaries

corresponding to the area (e.g., see page 4, lines 13-15 and Figures 2 and 3), and a memory for storing the area boundaries and absolute position data (e.g., see page 4, lines 14 and 15 and Figures 2 and 3), and a comparator for comparing the position data with the area information when the transmitter transmits the boundaries of the area to the at least one data carrier (e.g., see page 4, lines 16-26 and Figures 2 and 3).

The invention with respect to claim 3 comprises a method of locating an object provided with a data carrier located in an area (e.g., see page 3, lines 13-15 and Figure 1), the method comprising: the data carrier receiving position data from a position-determining system (e.g., see page 4, lines 1-3 and Figures 1-3); the data carrier transmitting position data to an information unit (e.g., see page 4, lines 3 and 4 and Figures 1-3); allocating the position data to an area in the information unit (e.g., see page 4, lines 9-12 and Figure 3); transmitting the boundaries of the area to the data carrier (e.g., see page 4, lines 12 and 13 and Figure 3); upon each movement of the data carrier comparing a position of the data carrier with the boundaries of the area (e.g., see page 4, lines 16-19 and Figure 3); transmitting new position data to the information unit only in the case of a negative result of the comparison of the area boundaries transmitted by the information unit with the position of the data carrier (e.g.,

see page 4, lines 19-24 and Figure 3); and interrogating the information unit from a third party for the position of the data carrier (e.g., see page 4, lines 29-31 and Figure 3).

The invention with respect to claim 4 comprises a method as claimed in Claim 3, wherein the position data transmitted by the data carrier is translated into area data in the information unit (e.g., see page 4, lines 8-11 and Figures 2 and 3) and the area in which the data carrier is located is stored in the information unit (e.g., see page 4, lines 14 and 15 and Figures 2 and 3).

VIII. STATEMENT/LIST OF EACH GROUND FOR REVIEW

1. **The rejection of Claims 1-4, on appeal, under 35 U.S.C. § 102, as being allegedly anticipated by Ladner is improper.**

A. CLAIMS 1 and 3

Ladner discloses a locator device (12), which is carried by a person (14). Upon activation of the device by the individual, the locator device transmits the most recently stored position information to a data processor station (18). The only other time that the locator device transmits the position information to the data processor station is upon an interrogation by the data processor station (column 3, lines 12-18). The data processor station compares the position

information to a map and sends the information to a responder (20).

Thus, in the device of Ladner, upon activation, the locator device transmits the most recently stored position to the data processor station. The data processor station of Ladner does not store area information and transmit the same to the locator device as is recited in claim 1. In the device recited in claim 1, the data carrier transmits its position to the information unit upon initialization and the information unit transmits area information from a memory that corresponds to the transmitted position. Thus, the locating device of Ladner does not have "an information unit which is remote from the at least one data carrier for storing area information and transmitting the area information to the at least one data carrier." Claim 3 has similar recitations.

Furthermore, the locator device of Ladner transmits its position information to the data processor station upon an interrogation by the data processor station. As discussed above, the data carrier recited in claim 1 transmits its position to the information unit upon initialization and the information unit transmits back stored area information corresponding to the position. After initialization, the data carrier only transmits its position back to the information unit upon movement of the data carrier from the area.

Therefore, the device of Ladner does not transmit "its position to the information unit only in the case of initialization and movement of the at least one data carrier from the area..." as is also recited in claim 1. Claim 3 has similar recitations.

In the Examiner's Response to Applicants previous arguments, the Examiner argued that the features upon which Applicants distinguish the claims over Ladner are recitations of intended use. The Examiner further argued that a recitation of the intended use must result in a structural difference in order to distinguish the claimed invention over the prior art.

In response, Applicants respectfully submit that the recitation of the data carrier transmitting its position to the information unit only in the case of initialization and movement of the data carrier from the area results in a structural difference over Ladner. Ladner does not have a means for a transmission upon such occurrences, whereas claim 1 recites such a means. In the Response Filed June 1, 2004, Applicants amended claim 1 to clarify that the transmitter transmits such position information to include a structural difference that is neither disclosed nor suggested in the Ladner locating device. However, as discussed above, such amendment has not been entered by the Examiner. Furthermore, claim 3 is a method claim that recites steps for performing a similar transmission under similar circumstances. Applicants

respectfully submit that no such structural differences need to be recited in a method claim because the method steps recited therein are neither disclosed nor suggested by Ladner.

In the Examiner's Response to Applicants previous arguments, the Examiner further argues that since the locating device of Ladner is capable of tracking movement of the locating device, the locating device must inherently transmit its position to the information unit whenever there is movement of the data carrier from the area.

Firstly, Ladner makes no disclosure or suggestion of such a feature. Applicants respectfully request that the Examiner support his arguments either within Ladner or with a showing that such a feature was known in the art.

Secondly, claim 1 recites that the data carrier "transmits its position to the information unit only in the case of initialization and movement of the at least one data carrier from the area..." Thus, there are only two circumstances where the data carrier of claims 1 and 3 transmit its position data, upon initialization and upon movement from the area. Even if it is inherent in Ladner to transmit position data upon movement from an area (which Applicants disagree), Ladner clearly discloses another circumstance where position data is transmitted from the locator device, namely, upon an interrogation from a data processor station. Therefore, Ladner

does not disclose or suggest a data carrier that transmits its position information only upon two occurrences, namely, upon initialization and movement from an area.

With regard to the rejection of claims 1 and 3, under 35 U.S.C. § 102(b), a locating system, having the features described above and as recited in independent claims 1 and 3, is nowhere disclosed in Ladner. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"¹ independent claims 1 and 3 are not anticipated by Ladner. Accordingly, independent claims 1 and 3 patentably distinguish over Ladner and are allowable.

B. CLAIMS 2 and 4

Claims 2 and 4 being dependent upon claims 1 and 3 are at least thus allowable therewith.

IX. CONCLUSION

Based on the above arguments and remarks, Appellants respectfully submit that the claims of the instant invention on appeal are not anticipated by Ladner. Consequently, the rejection of the claims based on the Ladner reference is in error. In view of the remarks submitted hereinabove, the

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485

reference applied against Claims 1-4 on appeal does not render those claims unpatentable under 35 U.S.C. § 102. Thus, Appellants submit that the § 102 rejection is in error and must be reversed.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment in connection herewith to Deposit Account No. 19-1013/SSMP.

Respectfully submitted,



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APPENDIX

CLAIMS ON APPEAL: CLAIMS 1-4
Application Serial No. 09/530,253

1. (Rejected) A locating system comprising:

at least one data carrier located in an area, the at least one data carrier including a position sensor, a transmitter and a receiver;

an information unit which is remote from the at least one data carrier for storing area information and transmitting the area information to the at least one data carrier;

wherein said at least one data carrier transmits its position to the information unit only in the case of initialization and movement of the at least one data carrier from the area and wherein a third party interrogates the information unit for the position of the at least one data carrier.

2. (Rejected) A locating system as claimed in Claim 1, wherein the at least one data carrier has a receiver for receiving area boundaries corresponding to the area, and a memory for storing the area boundaries and absolute position data, and a comparator for comparing the position data with the area information when the transmitter transmits the boundaries of the area to the at least one data carrier.

3. (Rejected) A method of locating an object provided with a data carrier located in an area, the method comprising:

the data carrier receiving position data from a position-determining system;

the data carrier transmitting position data to an information unit;

allocating the position data to an area in the information unit;

transmitting the boundaries of the area to the data carrier;

upon each movement of the data carrier comparing a position of the data carrier with the boundaries of the area;

transmitting new position data to the information unit only in the case of a negative result of the comparison of the area boundaries transmitted by the information unit with the position of the data carrier; and

interrogating the information unit from a third party for the position of the data carrier.

4. (Rejected) A method as claimed in Claim 3, wherein the position data transmitted by the data carrier is translated into area data in the information unit and the area in which the data carrier is located is stored in the information unit.

Claims 5 and 6. (Canceled)